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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,988	02/12/2002	Chris E. Rowen	OTG0002-US	3521
21912 7590 12/19/2006 VAN PELT, YI & JAMES LLP 10050 N. FOOTHILL BLVD #200 CUPERTINO, CA 95014			EXAMINER LESNIEWSKI, VICTOR D	
			ART UNIT 2152	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
3 MONTHS			12/19/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/072,988

Applicant(s)

ROWEN, CHRIS E.

Examiner

Victor Lesniewski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/19/2006</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed 9/22/2006 has been placed of record in the file.
2. Claims 1, 8, 15, 21, 29, 30, and 37 have been amended.
3. Claims 1-44 are now pending.
4. The applicant's arguments with respect to claims 1-44 have been fully considered but they are not persuasive. A detailed discussion is set forth below.

Continued Examination Under 37 CFR 1.114

5. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous office action has been withdrawn pursuant to 37 CFR 1.114. The applicant's submission filed on 9/22/2006 has been entered.

Information Disclosure Statement

6. The IDS filed 6/19/2006 has been considered.

Response to Amendment

7. Since some claims have been amended, the rejection of record will be restated taking into account the amendments, after which the applicant's arguments will be addressed.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mattis et al. (U.S. Patent Number 6,292,880), hereinafter referred to as Mattis, in view of Cloutier et al. (U.S. Patent Number 6,535,586), hereinafter referred to as Cloutier.

10. Mattis disclosed a method for caching information objects that uses object keys to detect duplicate objects. In an analogous art, Cloutier disclosed a method for generating a unique code for email messages in a system for the notification and retrieval of stored email.

11. Concerning claim 1, and like claims, Mattis did not explicitly state that his object is an email message and thus did not explicitly state retrieving a message from a mailbox on the electronic mail messaging system, the message including a plurality of properties. However, Cloutier's system is focused on the generation of unique codes or tags for email messages stored in a messaging system server based on message properties. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system of Mattis by allowing the objects to be email messages and thus adding the ability to retrieve a message from a mailbox on the electronic mail messaging system, the message including a plurality of properties as provided by Cloutier. Here the combination satisfies the need for an object store that efficiently stores large numbers of objects without content duplication. See Mattis, column

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4, lines 34-35. This rationale also applies to those dependent claims utilizing the same combination.

12. Concerning claims 5 and 6, and like claims, the combination of Mattis and Cloutier did not explicitly state computing the message tag by concatenating the sender's name, the sender's submission time, and the subject. However, the combination does state computing tags by concatenating data from an email header, especially noting the use of the "Date" and "From" fields. Although the sender's name is not explicit, this would be a clear extension of data in a "From" field of an email header. Although the sender's submission time is not explicit, this would be a clear extension of data in a "Date" field of an email header as various dates and times are often used in email headers. Although the subject is not explicit, this would be a clear extension of the system since the system utilizes data from the email header and an email subject line is exemplary of such data. Thus it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the combination of Mattis and Cloutier by adding the ability to compute the message tag by concatenating the sender's name, the sender's submission time, and the subject.

13. Some claims will be discussed together. Those claims which are essentially the same except that they set forth the claimed invention as an alternative method or a system are rejected under the same rationale applied to the described claim.

14. Thereby, the combination of Mattis and Cloutier discloses:

- <Claims 1, 8, 15, 21, 30, and 37>

A method for identifying a unique electronic mail message in a plurality of electronic mail messages extracted from an electronic mail messaging system, the method

comprising: retrieving a message from a mailbox on the electronic mail messaging system, the message including a plurality of message properties (Cloutier, column 5, line 40 through column 6, line 13); computing a message tag from at least a portion of the plurality of message properties (Mattis, column 8, lines 18-36 and column 8, line 55 through column 9, line 6); reviewing a list of message tags stored in a single shared index file associated with multiple electronic mail recipients (Mattis, column 8, line 55 through column 9, line 6 and column 10, lines 40-48; and for email recipients, Cloutier, column 3, lines 20-28); determining based upon whether the message tag is found in the single shared index file whether the message is not a duplicate message already stored in a message archive (Mattis, column 8, line 55 through column 9, line 6); and storing the message tag in the single shared index file and storing the message in the message archive if it is determined the message is not a duplicate message (Mattis, column 8, line 55 through column 9, line 6).

Claims 8 and 30 also contain limitations similar to Claim 5 discussed below.

- <Claims 2, 17, 22, and 38>

The method of claim 1, wherein the message tag is computed by concatenating at least two properties selected from the plurality of message properties (Mattis, column 9, lines 48-63 and Cloutier, column 6, lines 7-13).

- <Claims 3, 10, 18, 23, 28, 32, 39, and 44>

The method of claim 2, wherein the message tag is further computed by applying a hash algorithm to the message tag to form a uniform string, wherein the uniform string has a predetermined length (Mattis, column 9, lines 48-63).

- <Claims 4, 11, 19, 24, 33, and 40>

The method of claim 3, wherein the hash algorithm is an MD5 hash algorithm (Mattis, column 9, lines 48-63).

- <Claims 5, 9, 16, 26, 31, and 42>

The method of claim 1, wherein the plurality of message properties includes a sender's name and a sender's submission time, and wherein the message tag is computed by concatenating the sender's name to the sender's submission time (Cloutier, column 6, lines 7-13 and obviousness).

- <Claims 6, 27, 34, and 43>

The method of claim 1, wherein the plurality of message properties includes a sender's name, a sender's submission time and a subject, and wherein the message tag is computed by concatenating the sender's name and the subject to the sender's submission time (Cloutier, column 6, lines 7-13 and obviousness).

- <Claims 7, 13, 20, 29, and 35>

The method of claim 1, wherein the index file is stored in a relational database system (Mattis, column 10, lines 24-31).

- <Claims 12, 25, and 41>

The method of claim 8, wherein the first mailbox and the second mailbox are different mailboxes on the electronic mail messaging system (Mattis, column 8, lines 42-49).

- <Claims 14 and 36>

The method of claim 8, wherein the message archive is a relational database system (Mattis, column 7, line 66 through column 8, line 17).

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Since the combination of Mattis and Cloutier discloses all of the above limitations, claims 1-44 are rejected.

Response to Arguments

15. In the remarks, the applicant has argued:

- <Argument 1>

The combination of Mattis and Cloutier does not disclose the features of claim 1 because it does not disclose “a single shared index file associated with multiple electronic mail recipients” as recited in claim 1.

- <Argument 2>

The combination of Mattis and Cloutier does not disclose the features of claim 1 because it does not disclose “determining based upon whether the message tag is found in the single shared index file whether the message is not a duplicate message already stored in a message archive” as recited in claim 1.

16. In response to argument 1, the combination of Mattis and Cloutier does disclose a single shared index file as recited in claim 1. The previous line citation to Mattis, column 8, line 55 through column 9, line 6, shows the use of a cache associated with multiple users over the Internet. Although, Mattis doesn't state the use of email, Cloutier's system sets forth similar functionality in the use of an email server and a messaging system server over the Internet. Cloutier's email server serves mail to multiple recipients.

17. In response to argument 2, the combination of Mattis and Cloutier does disclose the determining step as recited in claim 1. As the applicant admits in the remarks, “the object key is

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used to detect duplicate objects.” Again, see the details of object key computation at Mattis, column 8, lines 18-36. In addition, Cloutier clearly teaches generating a message code (akin to the object key of Mattis) by using certain message properties. Thus, it is maintained that the combination of Mattis and Cloutier does teach using a message tag computed from message properties to detect a duplicate message. In response to the applicant's argument that Mattis does not teach message properties in the object key, the applicant is reminded that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

18. In addition, the applicant has argued that claims rejected under 35 U.S.C. 103, but not explicitly discussed, are allowable based on the above arguments. Thus, claims disclosing similar limitations to the discussed claims and related dependent claims remain rejected under the same reasoning as presented above.

Conclusion

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor Lesniewski whose telephone number is 571-272-3987. The examiner can normally be reached on Monday through Thursday.

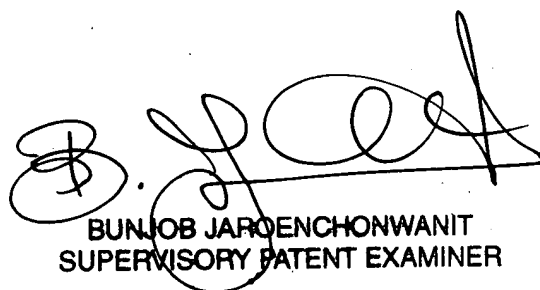
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571-272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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